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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,535	02/05/2004	Eizo Kanatani	248483US0	2817

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EXAMINER

STITZEL, DAVID PAUL

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1616

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Please find below and/or attached an Office communication concerning this application or proceeding.

OFFICIAL ACTION

Restriction/Election

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-7 and 11 are drawn to a liquid composition comprising an amide containing guanidine derivative of general formula (I) and a premix or concentrate of said liquid composition, as classified in class 424, subclass 405.
- II. Claim 8 is drawn to a wet tissue impregnated with said liquid composition, as classified in class 424, subclass 414.
- III. Claim 9 is drawn to an external agent for the treatment of skin comprising said liquid composition, as classified in class 424, subclass 401.
- IV. Claim 10 is drawn to a mouthwash comprising said liquid composition, as classified in class 424, subclass 49.

1. Claims 1-7 and 11 link Inventions I through IV. As such, claims 1-7 and 11 will therefore be examined herein on the merits for patentability along with the elected invention. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claims, namely claims 1-7 and 11. Likewise, upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from, or otherwise including all of the limitations of, the allowable linking claims will be entitled to examination in the instant application. Applicants are advised that if any such claim(s) depending from, or including all of the limitations of, the allowable linking claims is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting

rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 170 USPQ 129, 131-32 (CCPA 1971); and MPEP § 804.01.

Inventions I and II through IV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct. See MPEP § 806.05(j). In the instant case, the intermediate product of Invention I is deemed to be useful as a amide containing guanidine derivative liquid composition for controlling microbial growth in industrial water systems and thus precludes biofouling within said industrial water systems, and the final products of Inventions II through IV are deemed to be patentably distinct species, each with respect to the other, because there is nothing on this record to show them to be obvious variants. More specifically, the final products of Inventions II through IV are directed to related consumer products. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, wet tissues, external agents for the treatment of skin, and mouthwashes do not overlap in scope (i.e., are mutually exclusive), are not obvious variants, and are either not capable of use together, or can have a materially different design, mode of operation, function, or effect.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, the

prior art search required for each respective invention would be divergent, thereby causing an undue search burden. As a result, restriction for examination purposes as indicated is proper. Applicant is therefore required under 35 U.S.C. § 121 to elect a single invention for prosecution on the merits.

2. Claims 1-5 and 11 are generic to a plurality of disclosed patentably distinct species of component B comprising: 1. an inorganic salt; 2. an organic salt; 3. a nonionic surfactant; and 4. an ampholytic surfactant. The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of component B (i.e., an ampholytic surfactant) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 1-5 and 11 are generic. Applicant should also include a chemical structure of the elected compounds (i.e., carbobetaine-type, sulfobetaine-type, hydroxysulfobetaine-type, amide sulfobetaine-type, phosphobetaine-type, and imidazoline-type ampholytic surfactants), if a chemical structure of said compounds are not already contained within the instant specification.

Conclusion to Restriction Requirement

The Examiner has required restriction between claims directed to an intermediate product and patentably distinct species of final products.

Applicants are advised that a fully responsive reply to this requirement must include an explicit identification of not only a single disclosed patentably distinct species of component B

(i.e., an ampholytic surfactant), but also a chemical structure of the elected compounds (i.e., carbobetaine-type, sulfobetaine-type, hydroxysulfobetaine-type, amide sulfobetaine-type, phosphobetaine-type, and imidazoline-type ampholytic surfactants), if a chemical structure of said compounds are not already contained within the instant specification, that is elected consonant with this requirement, and a listing of all claims, including any claims subsequently added thereto, which are readable upon the elected species. An argument that a claim is allowable or that claims are not generic is considered nonresponsive unless accompanied by an explicit election of a specific species and subspecies. See 37 C.F.R. § 1.143.

Should Applicant traverse on the ground that the species of component B (i.e., an inorganic salt, an organic salt, a nonionic surfactant and an ampholytic surfactant) are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants over one another or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other inventions.

If claims are added after the election, Applicant must explicitly indicate which claims are readable upon the elected species. See MPEP § 809.02(a). Amendments submitted after final rejection are governed by 37 CFR 1.116, whereas amendments submitted after allowance are governed by 37 CFR 1.312.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named Inventors is no longer an actual Inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

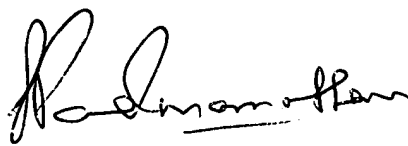
Contact Information

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, Esq. whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Sreenivasan Padmanabhan can be reached at 571-272-0629. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David P. Stitzel, Esq.


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER